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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,546	09/14/2004	David C Challener	RPS920020151US1	8260
53493	7590	12/21/2007		
LENOVO (US) IP Law 1009 Think Place Building One, 4th Floor 4B6 Morrisville, NC 27560			EXAMINER SONG, HOSUK	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/507,546

**Applicant(s)**

CHALLENGER ET AL.

**Examiner**

HOSUK SONG

**Art Unit**

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10507546</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,6-10,12-18,21-23,26 are rejected under 35 U.S.C. 102(e) as being anticipated by Whelan et al.(US 2004/0003285).

Claim 1: Whelan disclose monitoring access points through which data can be exchanged with a network in (page 1 [0011]). Whelan disclose identifying an unauthorized access point and monitoring traffic passing through the identified unauthorized access point in (pages 1-2 [0012]).

Claim 2: Whelan disclose determining the geographical location of the identified unauthorized access point in (page 3 [0031]).

Claim 3: Whelan disclose applying traffic filtering to monitored traffic passing through the identified unauthorized access point in (page 2[0017]).

Claim 6: Whelan disclose identifying an unauthorized access point comprises comparing the identity of monitored access points with a database of authorized access points in (page 2 [0017]).

Claim 7: Whelan disclose equipping each of plurality of computer devices to detect access points accessible to the device and to report to a server computer system the identity of detected access points in (page 2 [0015]).

Claim 8: Whelan disclose querying network nodes for recent entries into node identifying connectivity tables maintained at the nodes in (fig.1,2 and page 2 [0024]).

Claim 9: Whelan disclose monitoring is performed intermittently and periodically in (page 4, [0036]; page 5 [0050]).

Claim 10: Whelan disclose monitoring is performed at predetermined regular intervals in (page 5 [0050]).

Claim 12: Whelan disclose determining the geographic location of an identified unauthorized access point comprises comparing the locations of a plurality of computer devices in (page 3 [0029]).

Claim 13: Whelan disclose denying access to the network through the identified unauthorized access point in (page 1 [[0012]]).

Claim 14: Whelan disclose a computer system and a network interface connected to system and providing a communication channel between system and a network in (page 2 [0024]). Whelan disclose program instructions stored accessibly to computer system and cooperating with computer system when executing on computer system to monitor access points through which data can be exchanged with a network (page 1 [0012]) identifying an unauthorized access point and monitor traffic passing through an identified unauthorized access point in (page 2 [0015]).

Claim 15: Whelan disclose computer system is a workstation computer system and further wherein program instructions include an access point identification program cooperating therewith when executing on system to identify access points accessible through interface in (page 2 [0017]). Whelan disclose reporting program cooperating with identification program and with system when executing on system to report through interface to a remote server computer system the identity of accessed points in (page 3 [0028]).

Claim 16: Whelan disclose computer system is a server computer system and further program instruction include a node identification database cooperating therewith when program is executing on system to identify unauthorized access points accessible to system through interface in (page 2 [0017]).

Claim 17: Whelan disclose geographical location determining program effective when executing to derive the physical location of an unauthorized access point in (page 3 [0031]).

Claim 18: Whelan disclose a traffic filter controlling program effective when executing to selectively impose a filter on traffic exchanged with the network through an unauthorized node in (page 2[0017]).

Claim 21: Whelan disclose a computer readable medium and program instructions stored on medium accessibly to a computer system and effective when executing on a system to monitor access points through which data can be exchanged with a network in (fig. 1 and page 1 [0011]). Whelan disclose identify an unauthorized access point and monitor traffic passing through the identified unauthorized access point in (pages 1-2, [0012]).

Claim 22: Whelan disclose instructions effective to determine the geographical location of the identified unauthorized access point in (page 3 [0031]).

Claim 23: Whelan disclose instructions effective to apply traffic filtering to monitored traffic passing through the identified unauthorized access point in (page 2[0017]).

Claim 26: Whelan disclose instructions effective to compare the identity of monitored access points with a database of authorized access points in (page 2 [0015]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whelan et al(US 2004/0003285) in view of Fernandez et al(US 6,697,103).

Claim 11: Whelan does not specifically disclose monitoring is performed at random irregular intervals. Fernandez discloses this limitation in (col.12,lines 30-39). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ random irregular monitoring as taught in Fernandez with system of Whelan in order to secure its network resource by providing an unpredictable surveillance scheme which makes difficult for intruders to get an access to the network.

Claims 5,20,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whelan et al(US 2004/0003285).

Claims 5,20,25: Whelan does not specifically disclose accumulating charges for access and usage of network resources identified to the identified unauthorized access point. It would have been obvious to person of ordinary skill in the art to modify the invention of Whelan to charge access and usage of network resources identified to the identified unauthorized access point in order to deter fraudulent abuse by unauthorized users so that only authorized users can be allowed to its network resources.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-24: the claims directed to monitoring traffic passing through the identified unauthorized access point which lacks a useful, concrete and tangible result. A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom.

*Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the

conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,3,5-11,13-18,21-23,26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/208,281. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

Claims 4,19,24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***USPTO Contact Information***

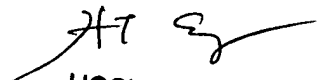
Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOSUK SONG whose telephone number is 5712723857. The examiner can normally be reached on mon-fri.

Application/Control Number:  
10/507,546  
Art Unit: 2135

Page 7

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM VU can be reached on 5712723859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
HOSUK SONG  
PRIMARY EXAMINER